

Applicant: Heller et al.
Application No.: 09/871,154

REMARKS/ARGUMENTS

After the foregoing Amendment, claims 35-50 are currently pending in this application. Claims 1-34 were previously canceled without prejudice.

Claim Rejections - 35 USC §112

Claims 35 and 42 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner indicated that the language “the database is configured to contain information regarding available channels, and wherein the database is located in a second network” as contained in claims 35 and 42 is not sufficiently described in the specification. Applicant respectfully submits that the original specification as filed adequately describes at least on page 6 lines 21-29 that “the database is located in a second network” (lines 27-28) and that the database contains “information regarding available channels” (lines 21-23). It is not necessary that the subject matter of a claim be described literally (i.e., using the same terms or in haec verba) in order for a disclosure to satisfy the description requirement. (See MPEP 2163.02.). New or amended claims may be supported in the specification through express, implicit, or inherent disclosure. (See MPEP 2163 I.B.)

Page 6 lines 21-23 describes information included in the database. Page 6 lines 27-28 relates to the location of the database. For at least these reasons, Applicant respectfully submits that the language of claims 35 and 42 does not violate 35 U.S.C. §112, first paragraph. Withdrawal of the 35 U.S.C. § 112 rejection of claims 35 and 42 is respectfully requested.

Claim Rejections - 35 USC §102

Claims 35-50 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dowling, U.S. Patent 7,035,932 (hereinafter “Dowling”). Applicant’s respectfully disagree.

The Examiner is reminded that “a claim is anticipated only if *each and every element as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference.” See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants respectfully submit that Dowling does not teach every element of independent claim 35. Specifically, claim 35 recites:

“a database wherein the database is configured to contain information regarding available channels, *and wherein the database is located in a second network*; ... a processor configured to determine whether to switch to a second communication interface based on the information received from the database regarding the available channels.”

Dowling teaches communications between a wireless client and a remote server. A wireless client downloads new submodules that include communication protocol software in order to communicate with the remote server. While Dowling teaches the remote server maintaining a listing of the submodules loaded on the wireless client Dowling does not teach, suggest or disclose a database “configured to contain information regarding available channels.” Nor does Dowling teach that the “database is located in a second network.” Moreover, Dowling teaches the server determines whether or not the client needs a submodule to communicate and either pushes the module to the client or sends a message to the client to download the submodule. In Dowling the client does not make the determination of which modules it should access and Dowling does not teach a WTRU determining “whether to switch to a second communication interface based on the information received from the database regarding the available channels.”

In this regard, each and every element as set forth in claim 35 is not found in Dowling and therefore Dowling does not anticipate independent claim 35. Based on the arguments presented above, withdrawal of the §102(e) rejection of claim 35 is respectfully requested.

Applicant: Heller et al.
Application No.: 09/871,154

Claim 42 is not identical to, but recites similar elements to claim 35. Claim 42 is not anticipated by Dowling for the reasons set forth above with respect to claim 35.

Claims 36-41 (which depend upon claim 35) and claims 43-50 (which depend upon claim 42) are not anticipated by Dowling at least by virtue of their dependence upon independent claims 35 or 42, respectively.

Based on the arguments presented above, withdrawal of the 35 U.S.C. § 102(e) rejection of claims 35-50 is respectfully requested.

Applicant: Heller et al.
Application No.: 09/871,154

Conclusion

If the Examiner believes that any additional minor formal matters need to be addressed in order to place this application in condition for allowance, or that a telephonic interview will help to materially advance the prosecution of this application, the Examiner is invited to contact the undersigned by telephone at the Examiner's convenience.

In view of the foregoing amendment and remarks, Applicants respectfully submit that the present application is in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

Heller et al.

By: Melissa D. Doogan/
Melissa D. Doogan
Registration No. 63,025

Volpe and Koenig, P.C.
United Plaza
30 South 17th Street
Philadelphia, PA 19103-4009
Telephone: (215) 568-6400
Facsimile: (215) 568-6499

MDD/dmc